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24

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,088	11/03/2003	Anton Rodi	AR-R10-CIP2	2798
24131	7590	09/23/2004	EXAMINER	
LERNER AND GREENBERG, PA			REIS, TRAVIS M	
P O BOX 2480			ART UNIT	
HOLLYWOOD, FL 33022-2480			PAPER NUMBER	
			2859	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,088

Applicant(s)

RODI, ANTON

Examiner

Travis M Reis

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031103.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 4, 7-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7-10 of copending Application No. 10/200901. Although the conflicting claims are not identical, they are not patentably distinct from each other because the language of the claims of the instant application "wherein the scale is a structured material characteristic or a structured surface on a material" is an obvious feature of the scale of Application 10/200901 since the scale would not be scannable by the scanning means if it was not part of a structure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2859

4. Claims 1-7, 9-14, & 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Masreliez et al. (U.S. Patent 5894678).

Masreliez et al. discloses a linear magnetic measuring system (100) for the recording of position absolute values where the scale (300) includes a machined measurement track (340) for generating absolute values (col. 5 lines 23-24) which is recorded by a scanning head/sensor (150), said scale with the measurement track is a structured pattern material characteristic being provided only in an operating range of sensors; said scale being composed of at least two segments (143) in track (310) of the scale (300) which are identically created with the same code selections (Figure 3) for the generation of the absolute values (col. 6 lines 30-43); and an auxiliary power battery (col. 11 line 21); wherein one suitable track (142) being at least one part of said measurement track and parallel to the track (310) is provided on the scale for determining the absolute value of the particular magnetic segment reached (Figure 3)(col. 5 lines 23-31), by means of a further sensor arrangement (350) and wherein a switching devices (430, 440) (Figure 10) are provided which use the absolute value of the segments and the calculated absolute value within the segment to provide the total absolute value for further processing via logical evaluation of the traversed segments from a defined starting position (Figures 1-3) (col. 5 lines 29-31; col. 10 lines 35-48).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2859

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masreliez et al. in view of Rieder et al. (U.S. Patent 4996778).

Masreliez et al. discloses all of the instant claimed invention as stated above in the rejection of claims 1-5, 7, & 8 including an external control system (170) (Figure 1).

Masreliez et al. do not disclose a second staggered scanning head/sensor whose measured values are used for redundant signal evaluation.

Rieder et al. discloses a position measuring system with a plurality of scanning heads/sensors to erase extraneous reference marks (col. 2 lines 51-64). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add a second scanning head/sensor disclosed by Rieder et al. to the scale disclosed by Masreliez in order that only correct data is processed.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masreliez in view of Heirmann et al. (U.S. Patent 4612267).

Masreliez discloses all of the instant claimed invention as stated above in the rejection of claims 1-7, 9-14, & 16 but does not disclose the measurement track is a lacquer layer structured with ultrasound.

Heitmann et al. disclose a process for producing structures in resist layers using ultrasonic irradiation in order to protect the structure to be lacquered without sacrificing measurement accuracy (col. 1 lines 12-15; col. 2 lines 30-33). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to apply lacquer and add ultrasound sensors as taught by Heitmann et al. to the scale disclosed by Masreliez in order to protect the scale without sacrificing measurement accuracy.

Art Unit: 2859

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spencer discloses a displacement measuring device (U.S. Patent 2861345). Aoki et al. discloses a detector for bi-directional movement of an extensible member in an electronic digital scale (U.S. Patent 4150282). Nelle discloses an incremental measuring instrument (U.S. Patent 4479716). Minami et al. discloses an encoder for length or angle measuring with high accuracy (U.S. Patent 4529964). Cheng discloses a power-driven tape measure (U.S. Patent 5471761). Andermo et al. discloses an electronic caliper using a reduced offset induced current position transducer (U.S. Patent 5901458). Nelle et al. discloses a linear encoder with a modular scale and a method of producing same (U.S. Patent 6163970).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
September 17, 2004


G. BRADLEY BENNETT
PRIMARY EXAMINER
A U 2859